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David A. Fell

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BRINKS HOFER GILSON & LIONE
P.O. BOX 10395
CHICAGO, IL 60610

EXAMINER

BOGART, MICHAEL G

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Please find below and/or attached an Office communication concerning this application or proceeding.

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/732,913
Filing Date: December 10, 2003
Appellant(s): FELL ET AL.

Amanda M. Miller
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 27 February 2008 appealing from the Office action mailed 27 September 2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(4) Status of Amendments After Final

The summary of claimed subject matter contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Copy of Appealed Claims in Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

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(8) Evidence Relied Upon

US 4,886,513	Mason, Jr. <i>et al.</i>	12-1989
US 6,015,934 A	Lee <i>et al.</i>	1-2000
US 2003/0114805 A1	Rainville-Lonn <i>et al.</i>	6-2003
US 6,429,350 B1	Tanzer <i>et al.</i>	8-2002

(9) Grounds of Rejection***Claim Rejections – 35 USC § 103***

The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. § 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. § 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out

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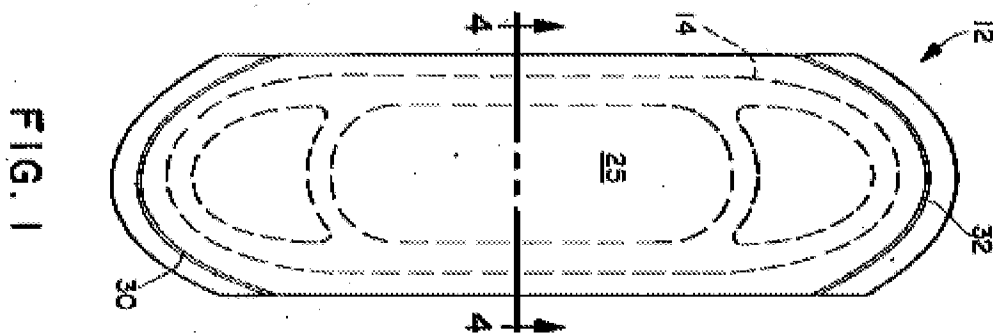
the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. § 103(c) and potential 35 U.S.C. § 102(e), (f) or (g) prior art under 35 U.S.C. § 103(a).

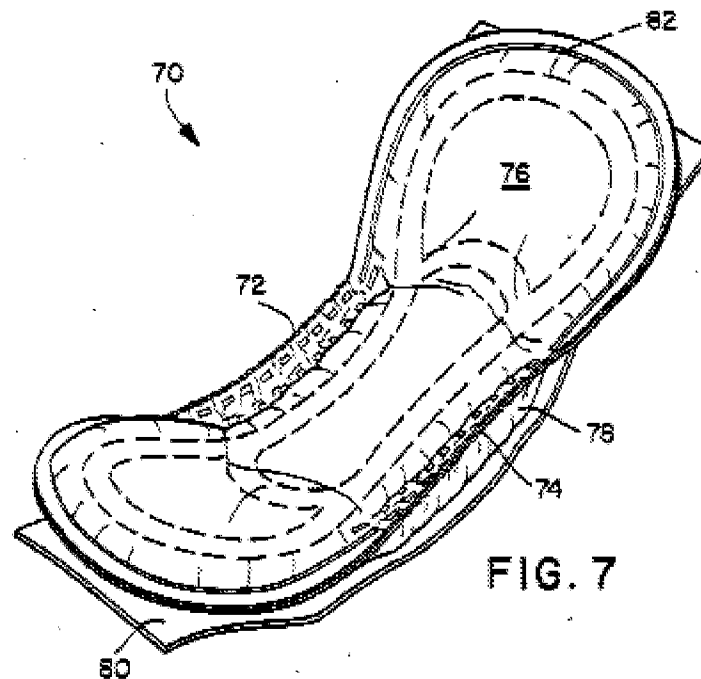
Claims 10-13 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Mason, Jr. *et al.* (US 4,886,513; hereinafter “Mason”) in view of Lee *et al.* (US 6,015,934 A; hereinafter “Lee”).

Regarding claims 10-12, Mason teaches an absorbent article (12) that resists permanent creasing comprising:

an absorbent core (14, 20) comprising an activation layer (14) and at least first and second opposite longitudinal end portions each defining a body side surface, wherein said absorbent article (12) is independently movable from a folded condition, wherein said body side surfaces of said first and second portions face will each other in a substantially parallel relationship under a sufficient applied pressure applied to said first and second portions, to an unfolded condition, wherein no pressure is applied to said first and second portions;

wherein said body-side surfaces of said first and second portions form at least one angle greater than or equal to about 90° to 130° in said unfolded condition (abstract)(see figures 1 and 7, *infra*).





Optimization of ranges of performance vectors or intrinsic properties will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such performance vector is critical. *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955). MPEP § 2114.05.

A particular parameter must first be recognized as a result-effective variable, i.e., a variable which achieves a recognized result, before the determination of the optimum or workable ranges of said variable might be characterized as routine experimentation. *In re Antonie*, 559 F.2d 618, 195 USPQ 6 (CCPA 1977)

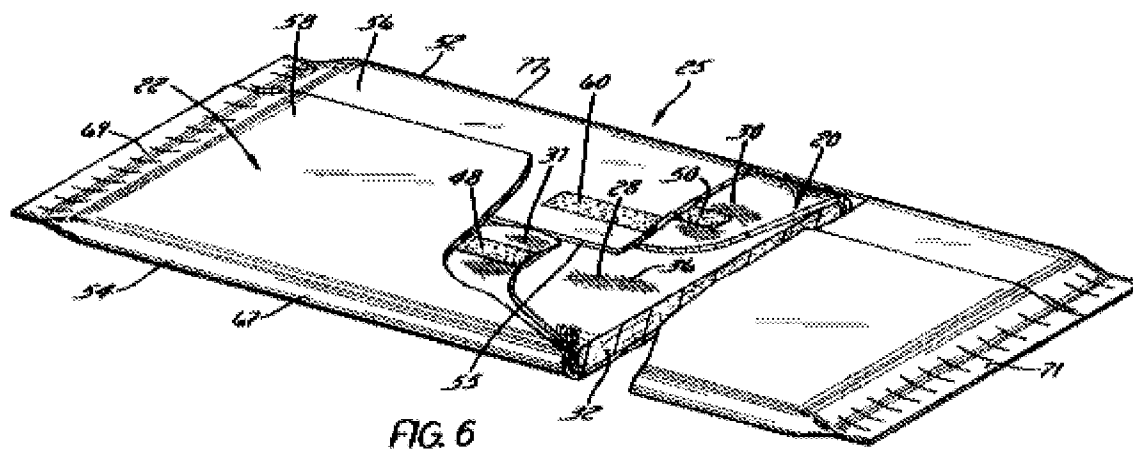
In the case of the device of Mason, making the resilient material such that it is increasingly able resist compressive force so that it can readily spring back into shape after deformation would come at the expense of wearer comfort as it would exert this resilience against a wearer and their garments. Conversely, reducing the spring recovery ability excessively by making it too willowy would result in an article that lacked adequate spring

recovery (a willowy material such as conventional cloth would have minimal spring recovery but would resist permanent folding).

Mason does not expressly disclose a packaging component.

Lee teaches a sanitary napkin (20) with a packaging component (22)(see fig. 6, *infra*).

At the time of the invention, it would have been obvious for one of ordinary skill in the art to use the packaging component of Lee to wrap the absorbent article of Mason in order to render it convenient for a wearer to transport in a pocket or purse.



Furthermore, where a claimed improvement on a device or apparatus is no more than "the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for improvement," the claim is unpatentable under 35 U.S.C. § 103(a). *Ex Parte Smith*, 83 USPQ2d 1509, 1518-19 (BPAI, 2007)(citing *KSR v. Teleflex*, 127 S.Ct. 1727, 1740, 82 USPQ2d 1385, 1396 (2007)). Accordingly, Applicant claims a combination that only unites old elements with no change in the respective functions of those old elements, and the combination of those elements yields predictable results; absent persuasive

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evidence that the modifications necessary to effect the combination of elements is uniquely challenging or difficult for one of ordinary skill in the art, the claim is unpatentable as obvious under 35 U.S.C. § 103(a). *Ex Parte Smith*, 83 USPQ2d at 1518-19 (BPAI, 2007)(citing *KSR*, 127 S.Ct. at 1740, 82 USPQ2d at 1396). Accordingly, since the applicant[s] have submitted no persuasive evidence that the combination of the above elements is uniquely challenging or difficult for one of ordinary skill in the art, the claim is unpatentable as obvious under 35 U.S.C. § 103(a) because it is no more than the predictable use of prior art elements according to their established functions resulting in the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for improvement.

Regarding claim 13, Mason teaches a third longitudinally central crotch portion located between the longitudinal end portions.

Claims 10-13 are rejected under 35 U.S.C. § 103(a) as obvious over Rainville-Lonn *et al.* (US 2003/0114805 A1; hereinafter “Rainville-Lonn”) in view of Lee.

Regarding claims 10-12, Rainville-Lonn teaches an absorbent article (10) that resists permanent creasing comprising:

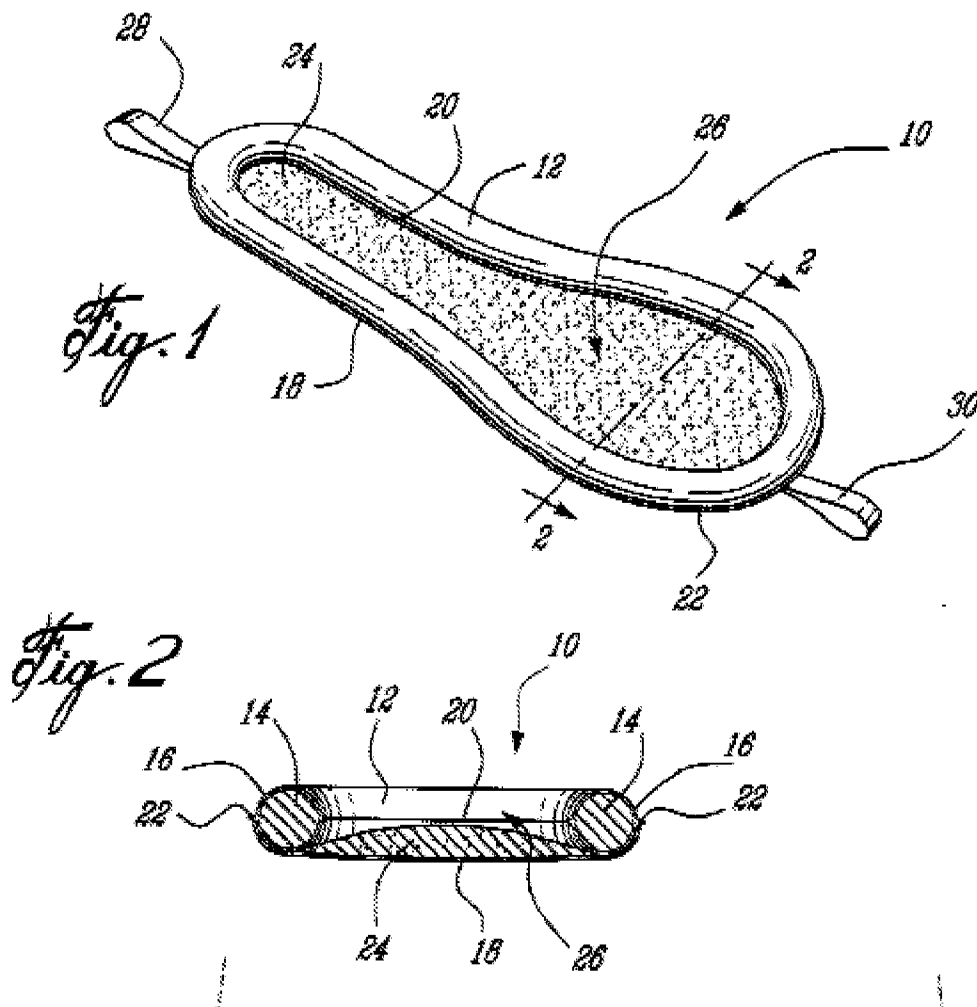
an absorbent core comprising an activation layer (14) and at least first and second opposite longitudinal end portions each defining a body side surface, wherein said absorbent article (10) is independently movable from a folded condition, wherein said body side surfaces of said first and second portions face will each other in a substantially parallel relationship under a sufficient applied pressure applied to said first and second portions, to an unfolded condition, wherein no pressure is applied to said first and second portions;

wherein said body-side surfaces of said first and second portions form at least one angle greater than or equal to about 90° to 130° (180° when in a flat configuration) in an unfolded condition (abstract)(see figures 1 and 2, infra).

Optimization of ranges of performance vectors or intrinsic properties will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such performance vector is critical. *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955). MPEP § 2114.05.

A particular parameter must first be recognized as a result-effective variable, i.e., a variable which achieves a recognized result, before the determination of the optimum or workable ranges of said variable might be characterized as routine experimentation. *In re Antonie*, 559 F.2d 618, 195 USPQ 6 (CCPA 1977)

In the case of the device of Rainville-Lonn, making the springy such that it is increasingly able resist compressive force so that it can readily spring back into shape after deformation would come at the expense of wearer comfort as it would exert this resilience against a wearer and their garments. Conversely, reducing the spring recovery ability excessively by making it too willowy would result in an article that lacked adequate spring recovery (a willowy material such as conventional cloth would have minimal spring recovery but would resist permanent folding).



Rainville-Lonn does not expressly disclose a packaging component.

Lee teaches a sanitary napkin (20) with a packaging component (22)(see fig. 6, supra).

At the time of the invention, it would have been obvious for one of ordinary skill in the art to use the packaging component of Lee to wrap the absorbent article of Rainville-Lonn in order to render it convenient for a wearer to transport in a pocket or purse.

Furthermore, where a claimed improvement on a device or apparatus is no more than "the simple substitution of one known element for another or the mere application of a known

technique to a piece of prior art ready for improvement," the claim is unpatentable under 35 U.S.C. § 103(a). *Ex Parte Smith*, supra.

Regarding claim 13, Rainville-Lonn teaches a third portion central crotch portion located between the longitudinal end portions.

Claims 14 and 16-21 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Rainville-Lonn and Lee as applied to claim 10 above, and further in view of Mason.

Rainville-Lonn teaches a foam layer (14) over a highly absorbent layer (24), but does not expressly teach the use of a superabsorbent (§ 0019).

Mason teaches the use of a superabsorbent to enhance absorbency (col. 6, lines 50-65).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to use the superabsorbent layer of Mason in the resilient sanitary napkin of Rainville-Lonn and Lee in order to provide enhanced absorbency.

Furthermore, where a claimed improvement on a device or apparatus is no more than "the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for improvement," the claim is unpatentable under 35 U.S.C. § 103(a). *Ex Parte Smith*, supra.

Further regarding claims 16-21, the references do not teach the specific caliper of the article.

Mere changes in size are not sufficient to patentably distinguish an invention over the prior art. See *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), cert. denied, 469 U.S. 830, 225 USPQ 232 (1984), the Federal Circuit held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the

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claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device.

Claims 15 and 22-24 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Rainville-Lonn, Lee and Mason as applied to claims 14 and 16 above, and further in view of Tanzer *et al.* (US 6,429,350 B1; hereinafter “Tanzer”).

Rainville-Lonn, Mason and Lee do not expressly disclose an absorbent open-celled foam layer over a superabsorbent layer.

Tanzer teaches an absorbent containing open cell foam layer (42) over a superabsorbent layer (58). This construction eliminates the need for redundant layers of material, allowing the final absorbent article to have a thin caliper (col. 6, lines 14-53)(fig. 3).

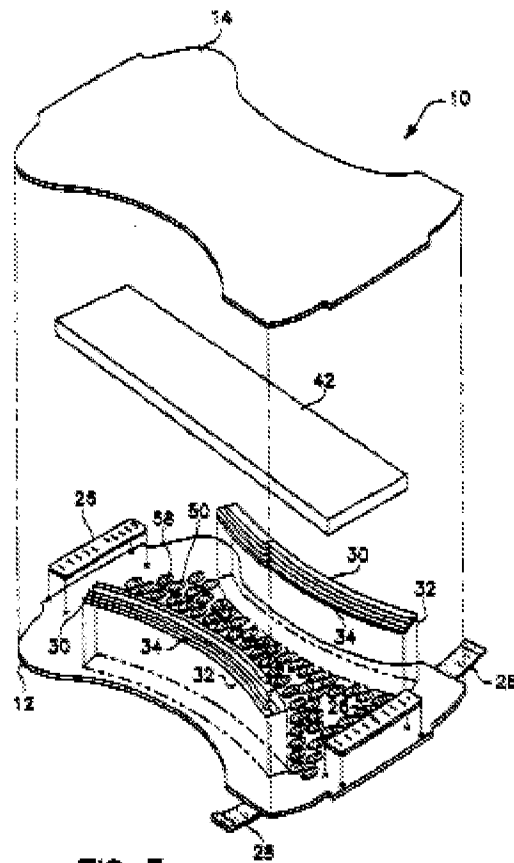


FIG. 3

At the time of the invention, it would have been obvious to one of ordinary skill in the art to use the foam and superabsorbent layer construction of Tanzer in the sanitary napkin of Rainville-Lonn, Mason and Lee in order to provide a thin caliper.

Furthermore, where a claimed improvement on a device or apparatus is no more than "the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for improvement," the claim is unpatentable under 35 U.S.C. § 103(a). *Ex Parte Smith*, supra.

(10) Response to Argument

Applicants assert that Mason and Lee do not disclose an absorbent article that is resistant to creasing even after having been subjected to the specifically claimed pressure of a folding machine. This argument is not persuasive because Mason teaches that the activation member may be in some embodiments "willowy" and is thus resistant to creasing (col. 5, lines 57-68). Regarding the article being resistant to creasing after being subjected to the specifically claimed amount of pressure, optimization within prior art conditions or through routine experimentation will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such parameter is critical.

Applicants assert that it would not have been obvious to use the reinforcing member of Mason with the claimed invention. This argument is not persuasive because as applied herein, Mason in view of Lee are applied to disclose or suggest the elements of the claimed invention. Whether it would have been obvious to combine a discrete element of Mason with the claimed invention is not relevant. The invention as claimed does not preclude a reinforcing member.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., Mason does not teach that the first absorbent member or the activating member is positioned only in the crotch region of the absorbent article) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicants assert that Mason discloses materials that would hold a permanent crease when subjected to 2800 psi of folded pressure. Applicants also argue that placing the pad of

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Mason into a packaging component would irreparably damage the reinforcing member. These arguments are not persuasive because Mason teaches that the reinforcing element may be made of a material that is willowy and will bend a great amount under pressure but will return to its original shape when pressure is released, thus resisting a permanent crease (col. 5, line 57-col. 6, line 15). Mason is silent as to the degree that such materials resist permanent creasing. See the discussion of optimization of ranges, *supra*.

Applicants assert that there is no evidence of a motivation or suggestion to modify the Mason or Lee references. This argument is not persuasive because Lee teaches that individually wrapped sanitary napkins are desirable because they are compact, transportable and prevent contamination (col. 1, lines 60-66). This provides motivation to add an individual wrapper to the sanitary device of Mason so that it may be compactly transported in a purse.

Applicants assert that Rainville-Lonn does not suggest to one of skill in the art that the disclosed pad would withstand the creasing when subject to the pressure recited by the claimed invention. This argument is not persuasive because Rainville-Lonn teaches that the resilient core (14) is made of a resilient material, such as a low density foam (§ 0017). One of ordinary skill in the art would have recognized that such a resilient core would be resistant to creasing.

Rainville-Lonn is silent as to the specific degree of resistance to creasing.

Regarding the article being resistant to creasing after being subjected to the specifically claimed amount of pressure, optimization within prior art conditions or through routine experimentation will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such parameter is critical.

In response to applicant's argument that Rainville-Lonn does not teach or suggest the use of a packaging component, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). Lee teaches that individually wrapped sanitary napkins are desirable because they are compact, transportable and prevent contamination (col. 1, lines 60-66). This provides motivation to add an individual wrapper to the sanitary device of Rainville-Lonn so that it may be compactly transported in a purse.

Applicants assert that articles such as those disclosed by Mason and Rainville-Lonn would be more subject to permanent creasing given their stiffness. This argument is not persuasive, because as discussed supra, Mason teaches that the activation member is “willowy” and thus resistant to creasing. Rainville-Lonn teaches a resilient pad that is made of a resilient low density foam that at least suggests a material that is resistant to creasing.

Applicants assert that Tanzer does not remedy the deficiencies of Rainville-Lonn, Mason and Lee. This argument is not persuasive for the reasons discussed in detail, supra.

In response to applicant's argument that Tanzer does not teach an activating member or a folded article, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the

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art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). Tanzer is only applied to show an absorbent article with an open-celled foam layer over superabsorbent.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Michael G. Bogart

/Michael G. Bogart/

Examiner, Art Unit 3761

Conferees:

Tatyana Zalukaeva

/Tatyana Zalukaeva/

Supervisory Patent Examiner, Art Unit 3761

/Nicholas D Lucchesi/

Supervisory Patent Examiner, Art Unit 3763

Nicholas Lucchesi